

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD E. ECKELS
and CARL H. KNAPKE

Appeal No. 1999-1803
Application 08/968,845

HEARD: 10 October 2001

Before JERRY SMITH, RUGGIERO and LEVY , Administrative Patent Judges.

SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-18, which constitute all the claims in the application.

The disclosed invention pertains to the protection of a terminal assembly for a compressor having a shell.

Representative claim 1 is reproduced as follows:

1. A terminal assembly for a compressor having a shell, said terminal assembly comprising:

a terminal block adapted to be secured to said shell;

a terminal fence adapted to be secured to said shell and defining a cavity, said terminal block being disposed within said cavity;

a power cable at least partially disposed within said cavity and having a molded plug and at least one electrical receptacle, said electrical receptacle being in electrical communication with said terminal block, said power cable sealingly engaging said fence to seal said cavity;

an intermediate gasket disposed between said molded plug and said terminal block, said intermediate gasket sealingly engaging said molded plug and said terminal block; and

a terminal block cover secured to said terminal fence for closing and sealing said cavity, said terminal block cover engaging said molded plug to bias said molded plug towards said intermediate gasket, to bias said intermediate gasket towards said terminal block and to bias said at least one electrical receptacle into said electrical contact with said terminal block.

The examiner relies on the following references:

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| Wisner | 5,336,105 | Aug. 09, 1994 |
| Shelly | 5,580,266 | Dec. 03, 1996 |
| Shevlin | FR 1,314,138 | Nov. 26, 1962 |

Claims 1-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Wisner in view of Shevlin and Shelly.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-18. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 3]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against

independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments.

See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner cites Wisner as teaching the claimed invention except for the use of an intermediate gasket with a plurality of sealing ribs and the power cable sealingly engaging the fence to seal the cavity. Shevlin is cited as teaching the use of an intermediate gasket with a sealing rib. Shelly is cited as teaching a plurality of sealing ribs to further enhance the sealing function of a gasket. The examiner asserts that “it would have been within the level of ordinary skill in the art to sealingly engage the power cable to the fence to seal the cavity to contain refrigerant in case of terminal venting” [answer, pages 4-5].

Appellants argue that none of the applied prior art teaches the power cable sealingly engaging the fence to seal the cavity defined by the fence as claimed. Specifically, appellants argue that the passage in Wisner referred to by the examiner to support this position does not do so. The passage in Wisner states that “external terminal shield 20 covers hermetic terminal assembly 24 to contain refrigerant in the unlikely case

of terminal venting” [column 4, lines 60-62]. Appellants argue that the disclosure by Wisner to contain refrigerant cannot possibly mean to sealingly contain the refrigerant. Appellants point to the holes in Wisner as evidence that the device of Wisner does not sealingly contain the refrigerant [brief, pages 5-6].

The examiner responds that appellants admitted that the power cable sealingly engaging the fence to seal the cavity defined by the fence was well known in the art. The examiner again states that “it would have been within the level of ordinary skill in the art to sealingly engage the power cable to the fence to seal the cavity to enhance the containment of refrigerant in case of terminal venting” [answer, page 5]. Appellants respond that they have not admitted that the power cable sealingly engaging the fence to seal the cavity defined by the fence was well known. Appellants also respond that the external shield of Wisner cannot sealingly contain any refrigerant [reply brief].

We agree with the position argued by appellants. Based on appellants’ brief, they have elected to let this appeal be decided on the very narrow question of whether the external shield of Wisner sealingly contains refrigerant. The examiner’s position that it would have been obvious or common sense for Wisner to have this feature is based on mere speculation by the examiner. There is nothing within the teachings of Wisner to suggest that this feature is necessary, desirable or even practical. The fact that the shield of Wisner has holes through which a refrigerant would likely leak certainly suggests that a

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complete seal was never intended by Wisner. It seems more likely that the shield in Wisner is merely used to prevent leaking refrigerant from directly spraying someone located near the compressor.

Since we agree with appellants on the narrow question of fact argued before us, we will not sustain the examiner's rejection of any of the appealed claims. Accordingly, the decision of the examiner rejecting claims 1-18 is reversed.

REVERSED

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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOSEPH F. RUGGIERO |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| STUART S. LEVY |) | |
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